

REMARKS

I. Status of the Claims

Claims 1-41 are pending in this application. No amendments are currently being made. Applicants respectfully request reconsideration of this application in light of the following remarks.

II. Rejection Under 35 U.S.C. § 103

Claims 1-41 are newly rejected under 35 U.S.C. § 103(a) as unpatentable over Japanese Application No. JP 11 - 021227 to *Takeshi* and U.S. Patent No. 5,976,510 to *Cernasov*. Applicants respectfully disagree with and traverse this rejection for at least the reasons set forth below.

To establish a *prima facie* case of obviousness, the Examiner bears the burden of establishing at least that one of ordinary skill in the art would have been motivated to combine the cited reference teachings and that there exists a reasonable expectation of success in such a combination. M.P.E.P. § 2143. As is explained below, the cited reference combination fails to satisfy these requirements.

The Examiner suggests that it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare a cosmetic composition by using the treated pigments of *Cernasov* in the composition of *Takeshi*. (Office Action dated June 4, 2003, page 3.) *Cernasov*, however, provides no motivation to use its pigments in any composition other than the one specifically taught by *Cernasov*.

At the outset, the present invention relates to gel compositions; *Cernasov* is strictly limited to oil-in-water emulsions. In addition, *Cernasov* credits itself with creating

a purportedly stable cosmetic formulation from the combination of the "specific oily phase with the specific pigments" disclosed therein. (*Cernasov*, col. 2, lines 7-9 (emphasis supplied).) *Cernasov* teaches that its pigments are dispersed in the oily phase of the emulsion in which the "dispersion is implemented essentially by using a selection from among the large number of available dispersants." (*Cernasov*, col. 2, lines 19-24 (emphasis supplied).) *Cernasov* teaches the use of two specific dispersants selected in a specific weight relationship to one another. (*Cernasov*, col. 2, lines 33-37.) It is this "special inventive combination" of *Cernasov* that purportedly provides surprising results. (*Cernasov*, col. 2, lines 63-67.) *Cernasov* fails to teach or suggest its treated pigments in another composition.

Additionally, the Examiner has not established that there exists a reasonable expectation of success in combining the treated pigments of *Cernasov* with the composition of *Takeshi*. This failure is especially significant here because *Takeshi* relates to a gel composition and *Cernasov* is strictly limited to oil-in-water emulsions. Each type of system exhibits uniquely different characteristics, and the ordinary practitioner would immediately recognize that one cannot simply swap ingredients without potentially fundamentally altering the nature of the respective compositions. For example, *Cernasov* recognizes the difficulties one could expect in formulating cosmetic compositions, such as combining individual components with conflicting characteristics. (*Cernasov*, col. 1, lines 12-14.) *Cernasov* emphasizes the importance of stability in the final product and cautions that "subsequent processing in certain cosmetic products is not generally possible due to the water and oil-repellent characteristics" of its treated

pigments. (*Cemasov*, col. 2, lines 1-3.) *Cemasov* and *Takeshi* together fail to establish a reasonable expectation of success.

Accordingly, because no *prima facie* case of obviousness has been established by the cited reference combination, Applicants request withdrawal of this rejection.

III. **Conclusion**

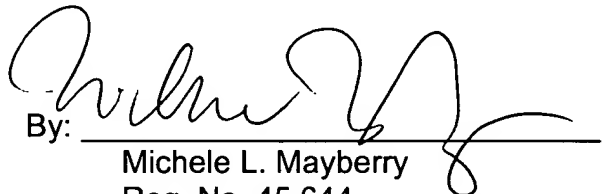
In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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